

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. FRANZINI

Appeal No. 97-3755
Application 08/079,338¹

ON BRIEF

Before MEISTER, STAAB and McQUADE, *Administrative Patent Judges*.

MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

John R. Franzini (the appellant) appeals from the rejection of claims 17 and 19.² Claims 1-16 stand allowed.³ Claims 18, 20 and 21, the only other claims present in the application, have been indicated as allowable subject to the requirement that they be rewritten to include all the

¹ Application for patent filed June 18, 1993.

² Claims 17 and 19 have been “twice rejected” within the meaning of 35 U.S.C. § 134.

³ The final rejection of claims 10, 11, 14 and 16 was withdrawn by the examiner in the answer (see page 2).

subject matter of the claims from which they depend.

We REVERSE.

The appellant's invention pertains to a firing mechanism adapter for a hammer initiated powder actuated connecting tool. Independent claim 17 is further illustrative of the appealed subject matter and reads as follows:

17. A firing mechanism adapter for a hammer initiated powder actuated connecting tool, the adaptor comprising:

a housing;

a striker movably connected to the housing;

a spring biasing the striker towards a firing position;

a cocking and trigger assembly connected to the housing, the assembly having a first lever arm pivotally connected to the housing and a second arm pivotally connected to the first arm; and

means for rotatably connecting the housing to an end of the connecting tool.

The reference relied on by the examiner is:

Larsson

3,816,951

June 18, 1974

Claims 17 and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Larsson. This rejection is explained on page 2 of Paper No. 11 wherein it is stated that:

Larssen [sic, Larsson] discloses a trigger mechanism for a cartridge tool which shows a housing (2), a spring biased striker (22), a cocking and trigger assembly comprised of first [sic] a first lever arm which is rotatably mounted to the housing through pin (43), and a second arm (47) pivotally connected to the first arm through pin (45). The front of housing (2) is rotatably connectable to the connecting tool (73).

In response to the appellant's argument that Larsson does not disclose or suggest a "firing mechanism adapter," the examiner has also taken the position that the preamble need not be accorded any weight because the body of the claim does not depend upon the preamble for completeness (see answer, pages 4 and 5).

We will not support the examiner's position. The question of whether a preamble or introductory clause constitutes a limitation to the claim is a matter to be determined by the facts of each case in view of the claimed invention as a whole. *In re Stencel*, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987). Here, the preamble of independent claim 17 sets forth "[a] firing mechanism **adapter** for a hammer initiated powder actuated **connecting tool**, the **adapter** comprising" (emphasis ours) and the body of the claim thereafter recites "means for rotatably connecting the housing [**of the adapter**] to an end of the **connecting tool**" (emphasis ours). It is thus readily apparent that the body of the claim does indeed depend upon the preamble for completeness and the limitations therein are necessary to give meaning to the claim and properly define the invention. *See Stencel, supra*.

Having determined that the preamble constitutes a limitation to claim 17, we find ourselves in agreement with the appellant that Larsson does not fairly teach or suggest an “adapter” as claimed. More specifically, terms in a claim should be interpreted in a manner consistent with the specification and construed as those skilled in the art would construe them. *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990), *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)). Here, consistent with the appellant’s specification, one of ordinary skill in this art would interpret the above-noted structure identified by the examiner in Paper No. 11 to be part of a connecting tool itself, rather than being a part of an “adapter” for a hammer initiated powder actuated connecting tool.

Additionally, we observe that independent claim 17 sets forth “a *cocking* and trigger assembly connected to the housing . . .” (emphasis ours). The levers 41, 46 of Larsson, however, while functioning as a “trigger” assembly (see, generally, column 8), do not serve as “cocking” mechanism or assembly as claimed. That is, it is the recoil of the cartridge 63 being fired in Larsson which “cocks” the assembly (see, generally, column 9).

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In view of the foregoing, the decision of the examiner to reject claims 17 and 19 under 35 U.S.C. § 102(b) as being anticipated by Larsson is reversed.

REVERSED

JAMES M. MEISTER
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

INTERFERENCES

JOHN P. McQUADE
Administrative Patent Judge

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